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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Yoshiko MIKAMI	:	Confirmation Number: 1909
	:	
Application No.: 10/632,160	:	Group Art Unit: 2152
	:	
Filed: July 31, 2003	:	Examiner: B. Whipple
	:	
For: NETWORK SYSTEM ALLOWING THE SHARING OF USER PROFILE INFORMATION AMONG NETWORK USERS	:	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed August 27, 2007, and in response to the Examiner reopening prosecution in the Office Action dated March 18, 2008, wherein Appellant appeals from the Examiner's rejection of claims 1-11.

I. REAL PARTY IN INTEREST

This application is assigned to IBM Corporation by assignment recorded on July 31, 2003, at Reel 014356, Frame 0854.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-11 are pending and three-times rejected in this Application. Claims 12-18 have been cancelled. It is from the multiple rejections of claims 1-11 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

The claims have not been amended subsequent to the imposition of the Third Office Action dated March 18, 2008 (hereinafter the Third Office Action).

V. SUMMARY OF CLAIMED SUBJECT MATTER

Referring to Figures 2, 5 and 10 and to independent claim 1, a method for use in a network system is disclosed. In S1004, S1005, host computer profile information relating to individual users of the host computer is stored, the profile information for a first user and a second user identifies host applications that the first user and the second user, respectively, are permitted to execute (paragraphs [0034], [0074] of Appellant's disclosure). In S1006, in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, the list is stored in the profile of the second user, and the second user is permitted to execute the applications in the list under control of the first user (lines 9-15 of paragraph [0020]; paragraph [0035]; lines 6-14 of paragraph [0077]).

Referring to Figures 2, 5, and 10 and to independent claim 5, a host computer for use in a network system is disclosed. The host computer includes storing means 550 (lines 1-3 of paragraph [0051]) and responding to request means 560 (lines 1-5 of paragraph [0053]). The storing means 550 stores profile information relating to individual users of the host computer 230 (lines 1-3 of paragraph [0051]). The profile information is for a first user and a second user and

identifies host applications that the first user and the second user, respectively, are permitted to execute (paragraphs [0034], [0074]). The request means 560 responds to a request from the first user identifying a list of one or more applications that the first user is permitted to execute for storing the list in the profile of the second user (paragraph [0076]). The second user is permitted to execute the applications in the list under control of the first user (lines 9-15 of paragraph [0020]; paragraph [0035]; lines 6-14 of paragraph [0077]).

Referring to Figures 2, 5 and 10 and to independent claim 9, a method for use in a network system is disclosed. In S1004, S1005, host computer profile information relating to individual users of the host computer is stored, the profile information for a first user and a second user identifies host applications that the first user and the second user, respectively, are permitted to execute (paragraphs [0034], [0074] of Appellant's disclosure). In S1006, in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, the list is stored in the profile of the second user, and the second user is permitted to execute the applications in the list under control of the first user (lines 9-15 of paragraph [0020]; paragraph [0035]; lines 6-14 of paragraph [0077]).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1-11 were rejected under 35 U.S.C. § 103 for obviousness based upon Gatz et al., U.S. Patent Publication No. 2002/0049806 (hereinafter Gatz), in view of Walker et al., U.S. Patent No. 6,286,001 (hereinafter Walker)

VII. ARGUMENT

THE REJECTION OF CLAIMS 1-11 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GATZ IN VIEW OF WALKER

For convenience of the Honorable Board in addressing the rejections, and claims 2-11 stand or fall together with independent claim 1.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."¹ The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.² "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."³ Therefore, to properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed and the teachings of the applied prior art. Moreover, before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.⁴

¹ In re Rijckaert, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

² KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1734 (2007).

³ Id. (quoting Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)).

⁴ See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Claim 1 recites "identifying a list of one or more applications that the first user is permitted to execute" and "the second user is permitted to execute the applications in the list under control of the first user." In the Examiner's cited passages, Gatz describes how a parent (i.e., allegedly disclosing the claimed first user) logs into a child account (i.e., allegedly disclosing the claimed second user) and is able to select/modify/control various aspects of the child account. Completely absent from these teachings, however, is a description of the "one or more applications that a [parent]⁵ is permitted to execute." Thus, Gatz fails to explicitly teach this limitation. Moreover, the list, as claimed, is of "one or more applications that the first user is permitted to execute." Assuming *arguendo* that Gatz discloses a list, such a list of the applications that the second user (i.e., the child) is permitted to execute.

The above-identified arguments were originally presented on page 4 of the First Appeal Brief. Referring to the paragraph spanning pages 3 and 4 of the Third Office Action and the paragraph spanning pages 4 and 5 of the Second Office Action, the Examiner is relying upon the same cited passages within Gatz and the same assertions as to the claimed limitations identified above. Thus, these same arguments previously-presented by Appellant are still applicable to the Examiner new rejection. Also, the Examiner has still failed to establish that Gatz teaches the claimed list of one or more application that the first user is permitted to execute. Therefore, the Examiner has failed to establish correct findings of fact as to the scope and content of Gatz.

On pages 4 and 5 of the First Appeal Brief, Appellant presented the following additional arguments. Since Gatz does not explicitly teach the claimed list of one or more application that the first user is permitted to execute, the Examiner argued that "the parent, as the controlling

⁵ The Examiner is relying upon the "parent" to teach the first user.

member of the online account, inherently has access to the applications being limited for other users as the parent could not grant full access to other users if the parent did not have full access." In this regard, Appellant submits that the Examiner's reliance upon the doctrine of inherency to disclose this feature is misplaced. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency.⁶ To establish inherency, the extrinsic evidence must make clear that the missing element must necessarily be present in the thing described in the reference, and that the necessity of the feature's presence would be so recognized by persons of ordinary skill.⁷ Furthermore, reference is made to ex parte Schricker,⁸ in which the Honorable Board of Patent Appeals and Interferences stated the following:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. Compare, In re Rijckaert, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); In re Yates, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden of indicating where the parent inherently has access to the applications been limited for other users appears in the prior art. Appellant is unaware of any technical requirement for the parent to have access, for example, to receiving e-mail or instant messaging, for the parent to provide to allow/deny access to the child for these features. Moreover, even if the parents inherently had access to the applications, the parent (i.e., allegedly corresponding to the claimed first user) may not be permitted to use the application (e.g., the

⁶ In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981).

⁷ Finnegan Corp. v. ITC, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); In re Robertson, 169 F.3d 743, 745 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746 (Fed. Cir. 1991); Ex parte Levy, 17 USPQ2d 1461 (BPAI 1990).

⁸ 56 USPQ2d 1723, 1725 (BPAI 2000).

parent chooses not to have access to the application or the parent is required to sign up for application, in order to user the application, and the parent has not).

In apparent response to the above-reproduced and previously-presented arguments, the Examiner stated the following in the first full paragraph on page 4 of the Fourth Office Action:

It may be argued that the parent does not inherently have access to the applications of the child. However, this is a minor and obvious scenario. A parent controlling a child's access to applications, where the parent has access to the applications, is extremely well known in the art. Often, the child has access to applications due to a parent's past experience with them. For example, a common scenario is a parent getting an AOL account and then assigning one of the available screen names to a child. Therefore, both the parent and the child would have access to programs such as IM, email, chat rooms, etc. Walker discloses one scenario where a parent has access to all applications, including a browser, using a parental password, but where the child has been limited to only the browser application through the use of said password (Col. 9, ln. 61 - Col. 10, ln. 4).

Thus, the Examiner, instead of asserting that the parent inherently has access to the same application as the child, is now asserting that it would have been obvious that the parent has access to the same application as the child.

The Examiner's obviousness involving the secondary reference of Walker is found in the last paragraph on page 4 and in the first paragraph on page 5 and is reproduced below:

Walker discloses permitting a first user to execute the programs being controlled by the first user for the second user (Col. 9, ln. 61 - Col. 10, ln. 4).

It would have been obvious to one of ordinary skill in the art to modify the teachings of Getz by permitting a first user to execute the programs being controlled by the first user for the second user as taught by Walker in order to allow a user to access desired programs.

Appellant is unclear as to the realistic benefit that would impel one having ordinary skill in the art to modify Walker in view of Getz in the manner proposed by the Examiner. Walker already allows a user to access a desired program. As such, the problem (i.e., allowing a user to access desired programs) being allegedly solved by Getz is already addressed by Walker. Since the

problem has already been solved, one having ordinary skill in the art would not have been realistically impelled to make the Examiner's proposed modification.⁹

The Examiner's analysis also neglects to consider that even if the parent has access to all the applications as the child, this access does not necessarily lead to the limitation at issue, which is "a list of one or more applications that the first user is permitted to execute." Neither Walker nor Getz appear to teach that a list of one or more application that the parent is permitted to execute since the parent (supervisor, etc.) appears to have access to the application by default. Thus, the systems of Walker or Getz do not require or involve the use of the aforementioned list. Thus, despite the Examiner's newly cited reference of Getz, the Examiner has still failed to establish that the applied prior art teaches, either alone or in combination, teach all of the limitations at issue.

⁹ See the non-precedential opinion of Ex parte Rinkevich, Appeal 2007-1317 ("we conclude that a person of ordinary skill in the art *having common sense* at the time of the invention would not have reasonably looked to Wu to solve a problem already solved by Savill") (emphasis in original).

Conclusion

Based upon the foregoing, Appellant respectfully submit that the Examiner's rejection under 35 U.S.C. § 103 based upon the applied prior art are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 102.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 17, 2008

Respectfully submitted,

/Scott D. Paul/
Scott D. Paul
Registration No. 42,984
Steven M. Greenberg
Registration No. 44,725
Phone: (561) 922-3845
CUSTOMER NUMBER 46320

VIII. CLAIMS APPENDIX

1. A method for use in a network system comprising:

storing at a host computer profile information relating to individual users of the host computer, the profile information for a first user and a second user identifying host applications that the first user and the second user, respectively, are permitted to execute,

in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, storing the list in the profile of the second user, whereby the second user is permitted to execute the applications in the list under control of the first user.

2. The method of claim 1 wherein the host computer executes any version of the HTTP protocol.

3. The method of claim 1 or claim 2 wherein an application in the list when executed performs a service from the second user to the first user.

4. The method of claim 1 or claim 2 wherein the storing step further comprises storing in the profile of the second user attributes that affect the execution of an application in the list.

5. A host computer for use in a network system comprising:

means for storing profile information relating to individual users of the host computer, the profile information for a first user and a second user identifying host applications that the first user and the second user, respectively, are permitted to execute,

means responsive to a request from the first user identifying a list of one or more applications that the first user is permitted to execute for storing the list in the profile of the second user, whereby the second user is permitted to execute the applications in the list under control of the first user.

6. The host computer of claim 5 further comprising means for executing an HTTP protocol.

7. The host computer of claim 5 or claim 6 wherein an application in the list comprises means for performing a service from the second user to the first user.

8. The host computer of claim 5 or claim 6 wherein the storing means further comprises second means for storing in the profile of the second user attributes that affect the execution of an application in the list.

9. A computer product for storing a computer software program, which when loaded into a computer and executed, causes the computer to perform a method comprising:

storing at a host computer profile information relating to individual users of the host computer, the profile information for a first user and a second user identifying host applications that the first user and the second user, respectively, are permitted to execute,

in response to a request from the first user identifying a list of one or more applications that the first user is permitted to execute, storing the list in the profile of the second user, whereby the second user is permitted to execute the applications in the list under control of the first user.

10. The computer product of claim 9 wherein an application in the list when executed by the computer performs a service from the second user to the first user.

11. The computer product of claim 9 or claim 10 wherein the storing step further comprises storing in the profile of the second user attributes that affect the execution of an application in the list.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.